

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner rejected claims 1-5, 7, 8, and 10-30 under 35 U.S.C. § 101; rejected claims 18, 19, 21, 41, and 52 under 35 U.S.C. § 112, second paragraph; rejected claims 1-7, 9-27, 30-52, and 57-61 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,003,011 to Sarin et al. ("*Sarin*"); and rejected claims 8, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over *Sarin*. Applicant has amended claims 1, 18-21, 31, 41, 42, 52, and 57; canceled claim 22 without prejudice or disclaimer; and added new claims 62-65. Claims 1-21 and 23-65 are pending in the application, with claims 53-56 withdrawn from consideration.

**I. The Rejection of Claims 1-5, 7, 8, and 10-30 under 35 U.S.C. § 101**

Applicant respectfully traverses the rejection of claims 1-5, 7, 8, and 10-30 under 35 U.S.C. § 101, as directed to non-statutory subject matter. The Office Action alleges that the rejected claims "fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus." (Office Action at page 3). Applicant submits that the element of "displaying a dashboard to the user," recited in claim 1, cannot be performed without the use of a display apparatus. Thus, claims 1-5, 7, 8, and 10-30 positively recite a process that is tied to a particular apparatus and are therefore statutory. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-5, 7, 8, and 10-30 under 35 U.S.C. § 101.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

**II. The Rejection of Claims 18, 19, 21, 41, and 52 under 35 U.S.C. § 112**

The Office Action rejects claims 18, 19, 21, 41, and 52 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action alleges that “it is unclear if each type of display is required.” (Office Action at page 3). Applicant notes that claims 18, 41, and 52 use the word “or” in listing the types of displays, which means that one or more types of displays may be provided. Furthermore, claims 19 and 21 depend from claim 18 and recite providing a particular type of display. Accordingly, Applicant respectfully requests that the rejection of claims 18, 19, 21, 41, and 52 under 35 U.S.C. § 112 be withdrawn.

**III. The Rejection of Claims 1-7, 9-27, 30-52, and 57-61 under 35 U.S.C. § 102(b)**

Applicant respectfully traverses the rejection of claims 1-7, 9-27, 30-52, and 57-61 under 35 U.S.C. § 102(b) as anticipated by *Sarin*. In order to properly establish that *Sarin* anticipates Applicant’s claims under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites a method including, for example:

displaying a dashboard to the user to display or link to status information of procedures started or monitored by the user, wherein at least one of the procedures is marked to alert the user that the procedure requires attention.

*Sarin* does not disclose at least this element of Applicant's claims.

*Sarin* discloses a workflow management system that copies an existing process instance and generalizes the process instance into a general process definition. (Col. 7, lines 1-7). *Sarin* further discloses that "individual tasks illustrated in Fig. 1, which could be shown as icons in a user interface, are graphical manifestation of underlying activities of the workflow software" and that "each individual task icon in effect 'calls forth' various other programs which appear on the screens of the persons or other entities who perform the work process." (Column 3, lines 46-48; column 4, lines 7-10). However, nothing in *Sarin* teaches displaying to the user a dashboard with status information of procedures started or monitored by the user, nor does *Sarin* teach marking the procedures that require the user's attention. Therefore, *Sarin* does not teach or suggest "displaying a dashboard to the user to display or link to status information of procedures started or monitored by the user, wherein at least one of the procedures is marked to alert the user that the procedure requires attention," as recited in claim 1.

As set forth above, *Sarin* fails to teach each and every element of claim 1. Accordingly, *Sarin* cannot anticipate claim 1. Claims 2-7, 9-21, 23-27, and 30 depend from claim 1 and are thus also allowable over *Sarin* for at least the same reasons as claim 1. Applicant has canceled claim 22, thereby rendering the rejection of this claim moot.

Independent claims 31, 42, and 57, while of different scope, recite elements similar to those of claim 1 and are thus allowable over *Sarin* for at least the same reasons discussed above with respect to claim 1. Claims 32-41, 43-52, and 58-61 are

also allowable over *Sarin* at least due to their dependence from claims 31, 42, and 57, respectively.

**IV. The Rejection of Claims 8, 28, and 29 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 8, 28, and 29 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. M.P.E.P. § 2142, 8th Ed., Rev. 6 (September 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. "[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). A *prima facie* case of obviousness has not been established because the rejection under 35 U.S.C. § 103(a) is not properly supported by a clear articulation of why the claimed invention would have been obvious.

Claims 8, 28, and 29 depend from independent claim 1. Claims 8, 28, and 29 thus incorporate each and every element of claim 1. As discussed above, *Sarin* fails to teach or suggest the elements recited in claim 1, and required by claims 8, 28, and 29.

Accordingly, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed combinations. Thus, the Office Action has failed to clearly articulate a reason why claims 8, 28, and 29 would have been obvious to one of ordinary skill in the art in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established with respect to these claims, and Applicant respectfully requests the withdrawal of the rejection of claim 8, 28, and 29 under 35 U.S.C. § 103(a).

**V. Official Notice**

The Office Action appears to take Official Notice, alleging that “it is old and well-known to provide exception handling within workflow systems,” that “it would have been obvious to one of ordinary skill in the art that the failure to determine a procedure trigger would render a procedure invalid,” and that “it is old and well-known to employ template wizards that enable a user to more accurately complete a template.” (Office Action at pages 8-9). Applicant respectfully traverses this taking of Official Notice.

The Office Action fails to provide documentary evidence sufficient to support the taking of Official Notice. Instead, the Office Action asserts that the subject matter of the Official Notice “is in the knowledge of an ordinary person skilled in the art.” Applicant submits that this unsupported statement cannot be the “explicit basis on which the examiner regards the matter as subject to official notice” as required by M.P.E.P. § 2144.03 (emphasis added).

Since the Office Action fails to provide sufficient evidence regarding the taking of Official Notice, withdrawal of the rejection of claims 8, 28, and 29 is respectfully requested for at least this additional reason.

**VI. New Claims 62-65**

New claims 62-65 are allowable at least due to their dependence from allowable independent claims 1, 31, 42, and 57, respectively.

**VII. Conclusion**

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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**Attachments:** Supplemental Information Disclosure Statement and Form SB-08.